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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Quantum Devices, Inc.

Serial No. 76/148,864

Robert D. Buyan of Stout, Uxa, Buyan & Mullins, LLP for
Quantum Devices, Inc.

Doritt Carroll, Trademark Examining Attorney, Law Office
116 (Meryl Hershkowitz, Managing Attorney).

Before Quinn, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On October 18, 2000, Quantum Devices, Inc. (a
California corporation) filed an application to register on
the Principal Register the mark shown below (in enlarged
form)

λ LIGHT

for goods ultimately amended to read "laser chips and laser modules for opto-electronic voice and data transmission" in International Class 9. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark shown below

Lambda StarLight

for "lasers for scientific and industrial use" in International Class 9,¹ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed.² Applicant stated in its brief (p. 2) "[A]n oral hearing is not requested."

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in

¹ Registration No. 2,380,179, issued August 29, 2000.

² The Examining Attorney's appeal brief was due on March 24, 2003. Although completed in a timely manner, the Trademark Examining Operation did not mail a copy of the appeal brief to applicant until May 23, 2003. The Examining Attorney's May 27, 2003 request that her late brief be considered is granted.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning to a consideration of the respective goods, the Examining Attorney contends that the goods are highly related, involving lasers or significant components of lasers, as shown by The American Heritage Dictionary (Third Edition 1992) definitions of (i) "chip" as "... 4.a. Electronics. A minute slice of a semiconducting material, such as silicon or germanium, doped and otherwise processed to have specified electrical characteristics, especially before it is developed into an electronic component or integrated circuit. Also called microchip. ..."; and (ii) "module" as "... 4. Electronics. A self-contained assembly of electronic components and circuitry, such as a stage in

a computer, that is installed as a unit.”³ The Examining Attorney also argues that applicant’s identified goods fall within the broad scope of the registrant’s goods, in that registrant’s “lasers for scientific and industrial use” could include lasers used for “opto-electronic voice and data transmission.”

Applicant argues that the involved goods “differ substantially” (applicant’s brief, p. 11). However, applicant provides no specific information about either its goods or the asserted significant and substantial differences between the respective goods.

It is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are or would be such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from or are associated with the same source or that there is an association or connection between the producers of

³ The Board takes judicial notice of the dictionary definitions submitted with the Examining Attorney’s brief. See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP Second Edition §704.12(a) (June 2003).

the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); and *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992).

Further, the Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the registration, and in the absence of any specific limitations in either, on the basis that all normal and usual channels of trade and methods of distribution will be utilized for such goods. See *Octocom Systems Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *Squirtco v. Tomy Corp.*, 697 F.2d 1034, 216 USPQ 937 (Fed. Cir. 1983).

While applicant's goods, as identified, are laser chips and modules specifically for opto-electronic voice and data transmission, registrant's goods are broadly identified, covering all lasers for all scientific and industrial uses, including voice and data transmission. Registrant's goods (lasers) could utilize applicant's goods (laser chips and laser modules). Both registrant's and

applicant's products may be used by the same class of consumers.

Based on this record, we find that applicant's "laser chips and laser modules for opto-electronic voice and data transmission" and registrant's "lasers for scientific and industrial use" are closely related goods.

Applicant strongly contends that the du Pont factor of "the sophistication of the purchasers and cost of the items" weighs heavily in applicant's favor, asserting that "among all the factors, [this factor] is perhaps the most determinative" (Response filed October 22, 2001, p. 3). Applicant describes the purchasers as "highly sophisticated and highly discriminating," and references "the extreme sophistication of purchasers of goods of this type." (Brief, pp. 9-11.)

However, as pointed out by the Examining Attorney, applicant offered no evidence of the sophistication of the purchasers. In fact, applicant has not suggested who the purchasers of its goods may be. Also, applicant offers no evidence of the cost of its goods (or those of registrant). The conclusion that there are manufacturers or other industrial users who would purchase both lasers and laser chips and laser modules because they may need to change or replace components in laser devices is as plausible as

applicant's unsupported contention that purchasers of lasers and laser components are separate and distinct.

The Board will assume, arguendo, that purchasers of lasers for scientific and industrial use, as well as purchasers of laser chips and laser modules are sophisticated. Nonetheless, sophistication of purchasers does not mean that such consumers are immune from confusion as to the origin of the respective goods, especially when sold under similar marks.⁴ See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). That is, even sophisticated purchasers of these lasers and laser chips and laser modules could believe that these goods come from the same source or have some relation, if offered under similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1992). For example, those who service

⁴ Applicant's reliance on the case of *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991) is unpersuasive. The facts of that case are readily distinguished from the facts here. (For example, the cited case involved an inter partes opposition proceeding, not an ex parte appeal; it included evidence about both parties' goods, channels of trade, etc.; and the marks in that case each involved significant design features in addition to the letters "HP" and "HPM," respectively).

industrial or scientific lasers may assume that applicant's laser chips and laser modules are suitable for use with registrant's lasers.

We turn next to consideration of the similarities or dissimilarities of the marks. Clearly there are some differences in the marks--the cited registrant's mark consists of the words LAMBDA STARLIGHT (in slightly stylized lettering--essentially simply showing upper and lower case letters), while applicant's mark consists of the Greek letter "lambda" and the word LIGHT.

Applicant contends that the marks are different in sound, appearance, connotation and commercial impression. Specifically, applicant points out that the marks consist of different styles of lettering, the "lambda" symbol appears only in applicant's mark and the word "starlight" appears only in registrant's mark; that the word "starlight" in registrant's mark connotes some "celestial relationship" whereas applicant's mark has a scientific or technical connotation; and that overall the marks create differing commercial impressions. Applicant acknowledges that the Greek letter in its mark would be spoken as "lambda" by arguing that its mark is an alliteration of two words beginning with the letter "L"; and applicant further argues that "this alliterative quality renders applicant's]

mark, as a whole, unique and memorable to consumers" (brief, p. 3) (emphasis in original), while registrant's mark has no such alliteration.

Applicant also contends that "similar marks are already used on or in connection with similar goods" (brief, p. 4);⁵ that the term "LAMBDA" is very common in trademarks as shown by a printout from the USPTO's Trademark Electronic Search System (TESS) showing 122

⁵ Applicant submitted Exhibits A-J with its brief on appeal. Exhibits A and B are information from an encyclopedia and are, as recognized by the Examining Attorney, proper material for judicial notice, which is hereby taken. Exhibits C, D and E were previously submitted by applicant with its response filed September 25, 2002, and are therefore already of record. However, Exhibits F-J are printouts from Internet web sites offered to show five uses of various "LAMBDA" marks in commerce. These were filed for the first time with the appeal brief. The Examining Attorney has properly objected to the exhibits, and her objection as to Exhibits F-J is sustained.

Applicant specifically requested in its brief (p. 12) that if the Board would not consider evidence not previously of record (its "Exhibits A-I" [sic - A-J]), then applicant requested that the Board remand the application to the Examining Attorney for consideration thereof. Applicant's alternative request for remand is denied. The record should be complete prior to the filing of the appeal. See Trademark Rule 2.142(d). The proper procedure for applicant to introduce evidence after filing an appeal is to file a request for remand, supported by an explanation of why the evidence was not previously submitted. Applicant did not separately request a remand, nor offer any explanation regarding why the information was not previously submitted. See *In re Compagnie Internationale Pour L'Informatique-Cii Honeywell Bull*, 223 USPQ 363, footnote 2 (TTAB 1984). (The case cited by applicant, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290, footnote 4 (TTAB 1995), involves significantly different facts.)

Applicant's Exhibits A-E have been considered by the Board, but we have not considered applicant's Exhibits F-J. Even if the Board had considered the latter exhibits, our decision would remain the same.

listings, and a separate printout with 61 listings in International Class 9, and applicant makes specific reference to three registrations in International Class 9 which existed at the time the cited registration issued; that "the word 'light' alone is of virtually no trademark significance in connection with lasers and optoelectronic apparatus"; and that "it is unfair" (brief, p. 7) for the USPTO to refuse registration to applicant.

Applicant did not provide copies of any of the referenced materials from its TESS search or of the three specific registrations. Thus, the probative value of this evidence is extremely limited. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Of course, applications have virtually no probative value on the issue of registrability, as they are evidence only of the fact that the applications were filed. Third-party registrations are not evidence of use, but they may show a term is commonly used in a particular field. Here, the USPTO TESS records submitted by applicant confirm the Examining Attorney's argument that the only registration including "LAMBDA" and "LIGHT" is the cited registration.

Finally, we note applicant's rather unusual argument regarding the marks (brief, pp. 3-4):

The non-juxtaposed words "LAMBDA" and "LIGHT" are commonly used as descriptive terms in connection with lasers and related optoelectronic devices. Indeed, the Board will recognize that lasers are devices which emit amplified LIGHT. ... (dictionary cite omitted) Thus, the term LIGHT is highly descriptive of lasers and such word alone has virtually no trademark significance in connection with lasers.

Furthermore, and [sic] all LIGHT has a wavelength which is indicated by the Greek letter lambda. (dictionary cite omitted) [The dictionary] explains that the Greek letter LAMBDA is the international recognized symbol for "wavelength," a physical property common to all light, including laser light. Thus, the term LAMBDA is also highly descriptive when used in connection with lasers, and is entitled to very little, if any, trademark significance.

The Examining Attorney, in turn, argues as follows
(brief, p. 3):

In the present case, both marks are dominated by the Greek letter "lambda" and the word "light." The combination of "lambda" with "light" creates a strong and unique mark. In fact, the registrant's and applicant's marks are the only marks on the Principal Register [sic-applicant has only applied to register its mark on the Principal Register] that use a version of "lambda" combined with a version of "light."

Specifically, she contends that the dominant features of both marks are the word or symbol "lambda" and the word

"light"; that in order to form its mark, applicant simply deleted the word "star" from the registered mark; and that the marks are very similar in sound, appearance, meaning and commercial impression.

It is well settled that marks must be considered and compared in their entirety, not dissected or split into component parts so that parts are compared with other parts. This is because it is the entire mark which is perceived by the purchasing public, and therefore, it is the entire mark that must be compared to any other mark. It is the impression created by each of the involved marks, each considered as a whole, that is important. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corp. v. Master Manufacturing Co.*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001).

Moreover, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved

marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corp., 206 USPQ 255 (TTAB 1980).

There are obvious differences between the registered mark LAMBDA STARLIGHT, and applicant's mark comprised of the Greek letter "lambda" and LIGHT. The Greek letter would be spoken as "lambda." The connotation of the registered mark may be slightly different in that the word "starlight" does bring to mind the celestial night sky, whereas applicant's use of the general word "light" does not. However, it is noted that registrant's mark shows the word with two capital letters as "StarLight" thus putting a separate emphasis on the word "light."

Applicant's use of the Greek letter in place of the word "LAMBDA" and deletion of the word "STAR" do not serve to sufficiently distinguish applicant's mark from that of the registrant, so as to avoid a likelihood of confusion.

We find that these marks, when considered in their entireties, although obviously not identical, are nonetheless similar in sound, appearance, connotation and commercial impression. See In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999). The contemporaneous use of the marks, in connection with these closely related goods, would be likely to cause confusion as to the source or sponsorship of such goods. See

Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and In re Dixie Restaurants Inc., supra.

Applicant argues regarding the du Pont factor of the fame of the prior mark that it does not believe the cited mark is famous or well known and the Examining Attorney has provided no evidence thereon. This argument is misplaced in the context of this ex parte appeal. Applicant's belief that the registered mark is not famous is not sufficient to make this du Pont factor one which is to be considered herein. The du Pont factor of fame of the prior mark is irrelevant because there is no evidence thereon. See Octocom v. Houston, supra, 16 USPQ2d at 1788.

Finally, applicant's argument that "it is unfair" (brief, p. 7) to maintain this refusal when there are other pending applications and registrations for marks which include the word "LAMBDA," is unpersuasive. The USPTO strives for consistency of examination, but as often noted by the Board and Courts, each case must be decided on its own merits. We are not privy to the records of the third-party registration files, and moreover, the determination of registrability of those particular marks by Trademark Examining Attorneys cannot control the merits in the case

now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

To the extent we have any doubt on the question of likelihood of confusion, it must be resolved against applicant as the newcomer, because the newcomer has the opportunity of avoiding confusion and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.